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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,839	11/21/2000	Klaus-Dieter Hammer	30098.6	3537

26633 7590 08/06/2002

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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7590

05/24/2002

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Office Action Summary

Application N .

09/700,839

Applicant(s)

HAMMER ET AL

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: .

DETAILED ACTION

Claims

1. Pursuant to entry of the Preliminary Amendment of November 21, 2000 (Paper No. 3), claims 1-15 are pending.

Information Disclosure Statement

2. The information disclosure statement submitted on November 21, 2000 (Paper No. 4) was considered by the examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- W/D
Dunk
4. Claims 14 and 15 provide for the use of the film of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 14 and 15 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- W/17
Add
6. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "and/or" renders the claim indefinite. Applicants may use additional dependent claims to cover embodiments that include or exclude various features, such as the preparation used on one or more of the inner and outer surfaces of their films.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- W/17 → 9. Claims 1, 2, 4, 6, 7, 9, 10, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastioli et al (US 5,412,005).

Bastioli teaches biodegradable compositions (title) that are used to make films (col. 16, line 22). The compositions contain starch or modified starch, Applicants' "a", (col. 2, lines 3-4) and the reaction products of polyesters with isocyanates, Applicants' "b", (col. 2, lines 5, 9-10 and 12). The a/b ratios used are 1:9 to 9:1 (col. 3, lines 42+). The compositions contain plasticizers (col. 10, line 3), crosslinkers (col. 10, line 50), lubricants (col. 10, line 51), and opacifiers (col. 10, line 56). The films can be extrusion blown (col. 16, line 18).

The examiner deems an opacifier, or colorant, to be a filler.

Bastioli fails to teach the hard and soft segments of the polyurethane of claim 4, the draw ratio specified in claims 1 and 13, the amounts of additives recited in claims 7-10, the heat sealability of the films (per claim 11) or the use of the film in casings (per claim 15).

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ suitable polyurethanes, draw ratios, and amounts of additives in the compositions of Bastioli in order to customize the films to the particular applications for which they were to be used.

Also, the selection of suitable types of polyurethanes, amounts of additives, and draw ratios would involve routine optimization of properties. *In re Boesch*, 205 USPQ-215 (1980).

The heat sealability of the Bastioli film would be expected to be similar to applicants' in view of the similarity of the reagents used in its compositions.

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Use in sausage casings is a matter of intended use. A recitation in the claims concerning the way in which an invention is intended to be used does not differentiate the claims from prior art satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

16 10. Claims 1-¹⁶ are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammer et al (US 5,928,737) in view of DD 247830A (abstract only).

Hammer teaches the production of sausage casings from thermoplastic starch compositions (title) that may be extruded and stretched (col. 1, lines 59-61). The compositions contain either 15-25% plasticizer (col. 3, line 8) or 0.5 to 20% plasticizer (col. 3, lines 13-14); 5 to 30% fiber (col. 3, lines 29-30); 3 to 25% protein; 2 to 15% crosslinker (col. 3, lines 34+), 2 to 12% lubricants (col. 4, line 4). An internal and/or external coating or impregnation may be used (col. 4, lines 41+).

The examiner takes official notice that a casing is a film.

The protein additive of Hammer is deemed to be a filler.

Hammer fails to teach the polyurethane ingredient, the hard and soft segments therein, or the draw ratio recited in claims 1 and 13.

DD 247830A ("the German abstract") teaches the blending of 60-98% thermoplastic polyurethane (first paragraph of abstract) with 2-40% starch (first paragraph of abstract) to make sausage skins (title). The polyurethane is made using various diols and diisocyanates (first paragraph of abstract). The German abstract teaches that the skins have good permeability to smoke (Use/advantage).

The examiner deems a "sausage skin" to be a sausage casing.

The references are analogous because both deal with the production of sausage casings.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the starch/polyurethane blends of the German abstract in the compositions of Hammer in order to make sausage casings that are smoke permeable.

The motivation to employ the starch/polyurethane blends of the German abstract in the compositions of Hammer is found in the use/advantage section of the German abstract, where the smoke permeability of the sausages casings made from the German abstract's blends is taught. It is deemed desirable to make sausage casings that are permeable to smoke so that foods contained in the casings can be smoked after they are encased to facilitate processing and storage.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ suitable polyurethanes from the German abstract and draw ratios for the films of Hammer in order to customize the films to the particular applications for which they were to be used.

Also, the selection of suitable types of polyurethanes and draw ratios would involve routine optimization of properties. *In re Boesch*, 205 USPQ 215 (1980).

The heat sealability of the German abstract's casings would be expected to be similar to applicants' in view of the similarity of the reagents used in their preparation.

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Conclusion

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan
Patent Examiner
Technology Center 1700

SMN/smn
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May 18, 2002